

DOCKET NO.: 218335US0CONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Shinichi KAWAMURA, et al.

SERIAL NO.: 10/051,230

FILED: JANUARY 22, 2002

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: GROUP ART UNIT: 1753

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: EXAMINER: RODEE

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4/16/02
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APR 15 2002
TC 1

FOR: AROMATIC POLYCARBONATE RESIN, ELECTROPHOTOGRAPHIC
PHOTOCONDUCTOR, PROCESS CARTRIDGE, AND
ELECTROPHOTOGRAPHIC IMAGE FORMING METHOD AND APPARATUS

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

In response to the Official Action dated March 13, 2002, Applicants elect, with traverse, Group II, Claims 17-24 and 31-42. In addition, Applicants elect, with traverse, polycarbonate resin No. 1 shown on page 90 of the specification. Claims 2, 8, 14, 24, 30, 36, and 42 read on the elected species.

REMARKS

The Office has restricted this application as follows under 35 U.S.C. §121:

Group I: Claims 1-16, drawn to a polycarbonate;

Group II: Claims 17-24 and 31-42, drawn to a photoconductor and apparatus and process cartridge containing the photoconductor; and

Group III: Claims 25-30, drawn to a method of imaging.

In addition, the Examiner is requiring an election of a single disclosed species as follows:

If Group I is elected, then elect the polycarbonates with

- 1) specific structural units having charge transporting properties; and
- 2) specific bisphenol ether units having R substituents.

If Group II or Group III is elected, then elect a single disclosed species of a structural unit having charge transporting properties.

Applicants elect, with traverse, Group II, Claims 17-24 and 31-42. In addition, Applicants elect, with traverse, polycarbonate resin No. 1 shown on page 90 of the specification. Claims 2, 8, 14, 24, 30, 36, and 42 read on the elected species.

The Office has characterized the inventions of Group II and Group I as related as combination and subcombination. Citing MPEP §806.05(c) the Office suggests that “the combination as claimed does not require the particulars of the subcombination as claimed because the polycarbonates may have up to near totality of units having a charge transporting group ... or may have only a single or other very small number of repeating units of the formula such that the amount of the structural unit having the charge transporting property is less than 5 weight percent of the polycarbonate.” The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

In regard to Groups I and II and Group III, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the product can be used in a materially different process such as “forming an electrostatic latent image on the surface of the photoconductor through the use of an ionographic stylus, developing the image with toner, removing unattached toner particles, and fixing the toner image on the surface of the photoconductor.” However, the Office has not provided sufficient reasons and/or examples to support this conclusion. Further, the Office has failed to show that the proposed process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the

Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants traverse the Restriction Requirement on the grounds that the Office has not shown that a burden exists in searching all the claims of the present application.

Moreover, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of

Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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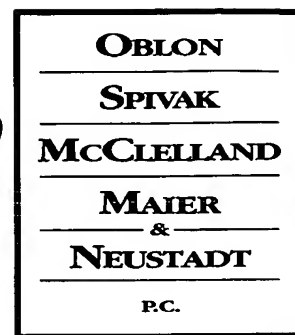


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RE: Application Serial No.: 10/051,230
Applicants: Shinichi KAWAMURA, et al.
Filing Date: January 22, 2002
For: AROMATIC POLYCARBONATE RESIN,
ELECTROPHOTOGRAPHIC
PHOTOCONDUCTOR, PROCESS CARTRIDGE,
AND ELECTROPHOTOGRAPHIC IMAGE
FORMING METHOD AND APPARATUS
Group Art Unit: 1753
Examiner: C.D. RODEE

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT (4 pp.)

Our check in the amount of 0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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